REMARKS

This application has been carefully reviewed in light of the Final Office Action mailed on July 23, 2009. Applicant respectfully requests consideration of the foregoing amendment in light of the following remarks.

Summary of the Office Action

In the Office Action of July 23, 2009, claims 22, 30-32 and 40-42 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 5,974,150 to Kaish (hereinafter referred to as "Kaish") in view of the document "Microsoft Computer Dictionary" (hereinafter referred to as "Microsoft") and further in view of the Examiner's Official Notice. Claims 27, 29, 37 and 39 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Kaish in view of Microsoft, and further in view of the alleged Admitted Prior Art. No other issues were raised.

Status of the Application

Upon entry of the present amendment, claims 22, 32 and 42 will have been amended. Accordingly, claims 22, 27, 29-32, 37 and 39-42 remain pending in the application.

Rejection of Claims 22, 30-32 and 40-42 under 35 U.S.C. 103(a) over Kaish, Microsoft and the Examiner's Official Notice

Claims 22, 30-32 and 40-42 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Kaish, Microsoft and the Examiner's Official Notice (*see, e.g.,* pages 2-7 of Office Action). This rejection is respectfully traversed.

Claim 22 is not obvious over Kaish, Microsoft, and the Examiner's Official Notice, because none of these references or notice teach or suggest the information processing apparatus as claimed, comprising:

"a providing unit programmed to provide an input screen for inputting a product name;

a database programmed to store registered trademark image information and genuine-product-specific information corresponding to the product name;

an input unit programmed to input product data acquired by scanning a product;

a determining unit programmed to *determine that the product is a genuine product* when the determining unit determines that the product data input by the input unit *includes the registered trademark image information and the genuine-product-specific information* in the database corresponding to the product name input in the input screen, *determine that the product is a counterfeit product* when the determining unit determines that the product data input by the input unit *includes the registered trademark image information* in the database corresponding to the product name input in the input screen and *does not include the genuine-product-specific information* in the database corresponding to the product name input in the input screen, and *determine that the product is a third party product* when the determining unit determines that the product data input by the input unit *does not include the registered trademark image information* in the database corresponding to the product name input in the input screen; and

a notification unit programmed to notify that the product is a genuine product when the product is determined to be a genuine product by the determining unit, *to notify that the product is a third party product when the product is determined to be a third party product by the determining unit*, and to notify that the product is a counterfeit product when the product is determined to be a counterfeit product by the determining unit" (emphasis added), as recited in the claim.

The information processing apparatus as claimed is thus capable of using

two pieces of product data, namely the registered trademark information and the genuine-product-specific information (e.g., a microcharacter) to determine not only whether a product is genuine vs. counterfeit, but also to determine whether a product *corresponds to a third party product*, i.e., is not the genuine product but is also not a counterfeit trying to imitate the genuine product. For example, as described in the instant specification (*see, e.g.,* Fig. 21 and paragraphs [0094]-[0108] of publication of instant application), the determining unit may first check to see whether or not first information corresponding to the *registered trademark information matching that for the product name* stored in the database is included in the scanned product data. *If not, then the product is determined to be a third party product*, because it does not include any trademark information identifying it as the genuine named product. If the registered trademark information *is* included, then the determining unit checks to see whether or not second information corresponding to the *genuine-product-specific information (e.g., a microcharacter or other genuine-product-specific information) matching that for the product name* stored in the database is included in the scanned product data. *If so, the product is determined to be genuine*, *if not, the product is determined to be counterfeit*, because the product is attempting to imitate the genuine product with the registered trademark information, but does not contain the specific information that authenticates it as actually being the genuine product.

The information processing apparatus is then capable of providing a notification to the user that the product is *either genuine, counterfeit, or a third party product*, based on the determination made by the determination unit. Embodiments of the apparatus as claimed may thus provide improvements in the identification of counterfeit products, by *not only* determining which products are not genuine, but also allowing for distinguishing between products that are counterfeit *versus those that are merely made by a third party*. The ability to distinguish between counterfeit and third party products may help in, for example, the reporting of more accurate counterfeit information to regulatory authorities (*see, e.g.,* paragraphs [0006]-[0008] of publication of instant application).

Kaish does not teach or suggest the information processing apparatus as claimed, because Kaish does not teach or suggest using _two pieces of information_, namely _both_ registered trademark information _and genuine-product-specific information_ to determine whether a product is genuine, counterfeit, or _a third party product_. Instead, Kaish teaches an authentication system where "a characteristic of the labeled object may also be encoded on the authentication certificate (label) in encrypted format" (column 9, lines 13-15.) Kaish further teaches that "it is possible for an inspector to validate the pattern (authenticate the label) with a hand held scanner. The label is authentic only if the scanner determines that the characteristics of the label and accompanying goods corresponds with the printed code on the label" (column 27, lines 31-35). Thus, Kaish teaches using _only one piece of information_, namely the encoded authentication certificate, to make a determination as to whether the product is genuine, counterfeit or a third party product, and does not teach or suggest using _both_ registered trademark information _and genuine-product-specific information_ to make this determination.

Kaish furthermore does not teach or suggest any means for _determining whether a product is a third party product versus being a counterfeit product_ (or genuine), nor does Kaish teach or suggest any means for _notifying_ of the determination of the product being a third party product. Instead, Kaish teaches that, with regard to determination and notification as to the authenticity of the product, "the scanner can read the code and provide a go/no-go indication" (column 27, lines 37-38). Thus, Kaish teaches determining whether a product is "authentic" based on reading of the code, and notifying as to whether or not the product is authentic, but Kaish _does not teach or suggest distinguishing between whether the product is counterfeit or just merely a third party product_, or notifying a user of such determination, and thus Kaish does not teach or suggest the information processing apparatus as claimed. Furthermore, as Kaish does not teach or suggest the desirability of being able to determine whether a product is

a third party product, as opposed to being counterfeit, it is considered that one of ordinary skill in the art would not have found it obvious to devise the claimed apparatus that can distinguish between the two based on the teachings of Kaish.

Microsoft does not make up for these deficiencies. Instead, Microsoft is referred to in the Office Action for its teachings of a touch screen for recognizing the location of a touch on its surface (*see, e.g.,* page 524 of Microsoft and page 4 of Office Action). Accordingly, Microsoft also does not teach or suggest using *two pieces of information*, namely *both* registered trademark information *and genuine-product-specific information* to determine whether a product is genuine, counterfeit, or *a third party product*, and also does not teach or suggest *notifying* as to the result of the determination.

The Examiner's Official Notice also does not make up for the deficiencies of Kaish and Microsoft. In particular, Applicant challenges the Examiner's factual assertion as (1) not being properly based on common knowledge, and (2) not being properly noticed (*see, e.g.,* MPEP 2144.03(C) – "If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence"). Applicant notes that **the Examiner is required to provide documentary evidence** of the factual assertions being made in the Official Notice in response to Applicant's challenge thereof, as set forth in MPEP 2144.03(c). If such documentary evidence cannot be produced, the Examiner is required to withdraw the rejection.

With regard to point (1), it is noted that the Examiner takes Official Notice that "it is old and well-known in the art that human beings would not confuse two separate products ... as this is the basis of commercial transactions. A human being would not look at a Samsung product and confuse it for a Canon product; as such, if the human were looking at a Canon product, he would not (sic) look for identifying marks which are only present on a Samsung product (e.g. a

holographic sticker which says "Samsung" or the like)" (paragraph 21 on page 5 of Office Action). Thus, the Examiner takes Official Notice that it is "known" that persons would not confuse one commercial product for another. The Examiner further notes that a person looking for Canon parts "would not report a Samsung product as 'counterfeit'; he would merely note that it is not a Canon product and move on to the next item" (paragraph 22 on page 5 of Office Action). The Examiner thus appears to indicate that the ability to distinguish between whether a part is counterfeit vs. from a third party is not of concern to those of ordinary skill in the art. The Examiner concludes that "it would have been obvious to a person having ordinary skill in the art to provide an automated mechanism for performing these tasks" (paragraph 23 on page 6 of Office Action).

Applicant disputes the Examiner's assertion in the Official Notice that it is old and well known in the art that human beings would not confuse two separate parts, and furthermore asserts that the ability to distinguish between counterfeit vs. third party is in fact of concern to those of ordinary skill in the art. In particular, Applicant refers the Examiner to the Background section of the instant application, where it is disclosed that "systems of the related art only determine whether or not a product is genuine product and thus cannot identify a counterfeit product among products in which compatible products (so-called "third party products") as well as genuine products and counterfeit products exist" (paragraph [0007] of publication of instant application). Accordingly, it is taught in the background section that the inability to distinguish between counterfeit and third parts is in fact a problem that is known in the art, and thus it is known that human beings (and automated systems) can in fact confuse two separate items, in direct contradiction to the Examiner's assertion. Such confusion may be due, for example, to unfamiliarity on the part of a person or system with a particular mark used by a company to identify a product. In fact, the inability to distinguish between genuine, counterfeit and third party products is precisely what is intended to be remedied according to embodiments of the invention. Accordingly, the factual basis for the Examiner's Official Notice is disputed as not being

properly based on what is considered to be common knowledge, and Applicant respectfully requests withdrawal of the rejection based on this Official Notice.

Regarding point (2), it is noted that, as described in MPEP2144.03(A), "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." Thus, in taking Official Notice, the facts must be "capable of instant and unquestionable demonstration as being well-known." Applicant respectfully notes that the Examiner has not held to this standard in taking Official Notice in this case. Rather than stating facts that are capable of "instant and unquestionable demonstration," the Examiner appears to have asserted various *behavioral tendencies* on the part of persons, such as that persons would not confuse one product with another, or that persons would not be concerned with distinguishing between counterfeit and third party products, as has been discussed above (*see, e.g.,* page 5 of Office Action). It is not clear how such behavioral tendencies are capable of "instant and unquestionable demonstration," as required in the taking of Official Notice, as the demonstration of such behavioral studies would appear to require long-term behavioral studies of groups of people under controlled circumstances, to assess the tendencies of persons in the situations cited. Accordingly, the Examiner's Official Notice is disputed as not being properly noticed, and Applicant respectfully requests withdrawal of the rejection based on this Official Notice.

Applicant reiterates that, in response to this challenge to the Examiner's Official Notice, the Examiner *is required to provide documentary evidence* of the factual assertions being made via Official Notice, such as long-term

behavioral studies of persons in relevant situations. If such documentary evidence cannot be provided, then the rejection of the claims on the basis of the Official Notice must be withdrawn (*see, e.g.* MPEP 2144.03(C)).

Applicant furthermore notes that the apparatus as claimed is nonetheless patentable over the alleged facts in the Examiner's Official Notice, because such alleged facts do not teach or suggest using *two pieces of information*, namely *both* registered trademark information *and genuine-product-specific information* to determine whether a product is genuine, counterfeit, or *a third party product*, and also do not teach or suggest *notifying* as to the result of the determination, as in the apparatus as claimed. Instead, as the alleged facts appear to suggest that one of ordinary skill in the art would *not be concerned* with being able to discriminate between counterfeit and third part products, as has been discussed above ("it is old and well-known in the art that human beings would not confuse two separate products ..." paragraph 21 on page 5 of Office Action), it is considered that the alleged facts of the Official Notice actually *teach against* the apparatus that is capable of distinguishing between genuine, counterfeit, and third party products, as claimed.

Accordingly, claim 22 is considered to be patentable over Kaish, Microsoft, and the Examiner's Official Notice, for at least those reasons as set forth above. Claims 30-31 depend from claim 22, and thus are also patentable over Kaish, Microsoft, and the Examiner's Official Notice, for at least the same reasons as their base claim.

Claim 32 is similar to claim 22, in that it is directed to a method for information processing in an information processing apparatus using a database to store registered trademark image information and genuine-product-specific information corresponding to a product name, the method comprising:

"a providing step of providing an input screen for inputting the product name;

an inputting step of inputting product data acquired by reading a product by a scanner;

a first determining step of determining whether the product data input in the inputting step includes the registered trademark image information in the database corresponding to the product name input in the input screen;

a second determining step of determining whether the product data input in the inputting step includes the genuine-product-specific information in the database corresponding to the product name input in the input screen;

a third determining step of determining whether the product is a genuine product, a counterfeit product or a third party product, in accordance with a determination result in the first determining step and the second determining step; and

a notification step of notifying that the product is a genuine product when the product is determined to be a genuine product in the third determining step, of notifying that the product is a third party product when the product is determined to be a third party product in the third determining step, and of notifying that the product is a counterfeit product when the product is determined to be a counterfeit product in the third determining step" (emphasis added).

Accordingly, neither Kaish, Microsoft nor the Examiner's Official Notice teach or suggest the method for information processing as recited in claim 32, because they do not teach or suggest using *two pieces of information*, namely *both* registered trademark information *and genuine-product-specific information* to determine whether a product is genuine, counterfeit, or *a third party product*, as has been discussed above. Accordingly, claim 32 is patentable over the teachings of Kaish, Microsoft and the Examiner's Official Notice, for at least the same reasons, discussed above, as claim 22. Claims 40-41 depend from claim 32, and thus are also patentable for at least the same reason as their base claim. Claim 42 is directed to a computer-readable storage medium corresponding to the method of claim 32, and thus is also patentable over Kaish, Microsoft and the Examiner's Official Notice, for at least the same reasons as that claim.

Accordingly, claims 22, 30-32 and 40-42 are patentable over Kaish, Microsoft and the Examiner's Official Notice, and the rejection of the claims under 35 U.S.C. 103(a) over these references is respectfully requested to be withdrawn.

Rejection of Claims 27, 29, 37 and 39 under 35 U.S.C. 103(a) over Kaish, Microsoft and the Alleged Admitted Prior Art

Claims 27, 29, 37 and 39 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Kaish, Microsoft and the alleged admitted prior art (*see, e.g.,* pages 7-9 of Office Action). This rejection is respectfully traversed.

Claims 27 and 29 depend from claim 22, and thus are patentable over the teachings of Kaish and Microsoft for at least the same reasons, discussed above, as their base claim, and namely because neither of the references teaches or suggests using *two pieces of information*, namely *both* registered trademark information *and genuine-product-specific information* to determine whether a product is genuine, counterfeit, or *a third party product*, and also does not teach or suggest *notifying* as to the result of the determination, as in the apparatus as claimed.

The admitted prior art as alleged by the Examiner does not make up for these deficiencies. In particular, with regard to claim 27, the Examiner alleges that "using micro-characters … was well-known to those skilled in the art" (paragraph 32 on page 7 of Office Action). With regard to claim 29, the Examiner alleges that "[i]t is now Admitted Prior Art (under MPEP 2144.03(c)) that user information is transmitted to the remote site" (paragraph 34 on page 8 of Office Action). Applicant does not agree with these assertions. However, even if these assertions had a basis in fact, they nevertheless would not constitute a teaching or a suggestion of using *two pieces of information*, namely *both* registered

trademark information *and genuine-product-specific information* to determine whether a product is genuine, counterfeit, or *a third party product*, nor a teaching or a suggestion of *notifying* as to the result of the determination, as in the apparatus as claimed.

Accordingly, claim 22, as well as claims 27 and 29 depending therefrom, are considered to be patentable over the teachings of Microsoft and the alleged admitted prior art.

Claim 32, from which claims 37 and 39 depend, is directed to a method for information processing in an information processing apparatus using a database to store registered trademark image information and genuine-product-specific information corresponding to a product name, and is patentable over the teachings of Kaish and Microsoft for at least the reasons discussed above. In particular, claim 32 is patentable over the references because neither of the references teaches or suggests using *two pieces of information*, including *both* registered trademark information *and genuine-product-specific information* to determine whether a product is genuine, counterfeit, or *a third party product*, and the references also do not teach or suggest *notifying* as to the result of the determination, as in the method as claimed.

The admitted prior art as alleged by the Examiner does not make up for these deficiencies. In particular, with regard to claim 37, the Examiner alleges that "using micro-characters … was well-known to those skilled in the art" (paragraph 32 on page 7 of Office Action). With regard to claim 39, the Examiner alleges that "[i]t is now Admitted Prior Art (under MPEP 2144.03(c)) that user information is transmitted to the remote site" (paragraph 34 on page 8 of Office Action). Applicant does not agree with these assertions. However, even if these assertions had a basis in fact, they nevertheless would not constitute a teaching or a suggestion of using *two pieces of information*, namely *both* registered trademark information *and genuine-product-specific information* to determine

whether a product is genuine, counterfeit, or _a third party product_, nor a teaching or a suggestion of _notifying_ as to the result of the determination, as in the apparatus as claimed.

Accordingly, claims 27, 29, 37 and 39 are patentable over Kaish, Microsoft and the alleged admitted prior art, and the rejection of the claims under 35 U.S.C. 103(a) over these references is respectfully requested to be withdrawn.

CONCLUSION

Applicant respectfully submits that all of the claims pending in the application meet the requirements for patentability, and respectfully requests that the Examiner indicate the allowance of such claims. Any amendments to the claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If any additional fee is required, please charge Deposit Account Number 502456. Should the Examiner have any questions, the Examiner may contact Applicant's representative at the telephone number below.

Respectfully submitted,

9/14/2009   /Abigail Cotton/

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